

### **REMARKS**

The Examiner rejects claims 1-49 under §103 over Aulick in view of Kinoshita.

Applicant respectfully requests reconsideration in view of the following remarks.

#### **Claims 1-14**

Independent claim 1 requires, *inter alia*, a metallic coating on a flexible metallic substrate, with the coating comprising molybdenum and/or tungsten carbide. The Examiner, in rejecting claim 1, relies mainly on Aulick, but then proposes to modify Aulick according to Kinoshita.

Applicant first notes that Aulick suggests that tungsten carbide coatings have been used in prior art doctor blades, but only in the context of a rigid doctor blades. Further, there is no cited teaching in Aulick as to how to create tungsten carbide coatings in any way; indeed, the sole mention of tungsten carbide coatings is in the context of teaching away from using tungsten carbide as a coating on doctor blades (Aulick, col. 1, line 67 to col. 2, line 2 ("This doctor blade [of the Aulick invention]...does not require an expensive tungsten carbide coating as the doctoring surface.")). Applicant therefore questions whether Aulick provides an enabling teaching with respect to tungsten carbide coatings on doctor blades, much less doctor blades having flexible metallic substrates. Indeed, Aulick does not appear to disclose other than using an aluminum coating layer on the specific structure claimed by Aulick. Further, there is no disclosure in Kinoshita of any sort of coating on the doctor blade at all, much less tungsten carbide. Thus, Applicant respectfully submits that the Examiner has failed to show how either cited reference, alone or in combination, shows one of skill in the art

how to create a tungsten carbide coating on a flexible metallic substrate, as claimed.

Applicant also respectfully points out that the law is well settled that the combination of references put forth by the Examiner must have enabling disclosures for the subject matter claimed in the application at issue in order to establish a prima facie case of obviousness. Simply put, the combination of Aulick and Kinoshita, assuming *arguendo* that such combination is proper, has not been shown to be enabling with respect to a tungsten carbide coating, and the Examiner has pointed to nothing in the record to the contrary. As such, Applicant respectfully submits that the Examiner has failed to set forth a prima facie case of obviousness with respect to independent claim 1.

Applicant also notes that the structure taught by Aulick is by its nature flexible in the contact area. As such, Applicant challenges the Examiner to explain where the motivation is found for one of skill in the art to modify Aulick at all. Aulick already provides a doctor blade with a flexible contact portion having an aluminum coating. Given that Aulick plainly teaches away from tungsten carbide coatings (and Kinoshita says nothing about a coating), where does the motivation come from to modify Aulick to mysteriously substitute in a tungsten carbide coating? Applicant respectfully submits that the motivation comes from impermissible hindsight reconstruction by the Examiner. If not, then Applicant respectfully requests that the Examiner more fully explain the rationale, with specific pinpoint references to the passages relied on in any cited document. On this point, Applicant respectfully reminds the Examiner that the fact that the references may be combined or modified does not rend the resultant combination obvious unless the prior art also suggests the desirability of the combination, MPEP §2143.01. Further, the Examiner must identify this suggestion and clearly and

particularly cite the alleged support, and this requirement is not met by broad and conclusory statements about the teachings of the references. *In re Dembiczak*, 50 USPQ2d 1614,1617 (Fed. Cir. 1999); *accord, In re Kotzab*, 55 USPQ2d 1313,1317 (Fed. Cir. 2000).

Applicant next notes that the Examiner has not established a prima facie case of obviousness for any of dependent claims 2-14. Each of these dependent claims adds limitations; however, the Examiner never even mentions any of these limitations in the Action in any way whatsoever. For example, dependent claim 3 requires that the coating be "a thermal sprayed coating of a thickness of not more than 30 um." Nowhere in the Action does the Examiner mention the coating thickness or a thermally sprayed coating. Nowhere in the Action does the Examiner make the specific citations to any passages in the cited art that allegedly show these limitations. The same can be said the other dependent claims. Accordingly, the Examiner has plainly not established a prima facie case of obviousness for the these claims in any fashion that can be said to comport with the requirements of the MPEP and the law. Therefore, Applicant submits that these claims define patentable subject matter over the cited art.

With further regard to amended dependent claim 12, this claim now requires, *inter alia*, that that metallic coating directly contact the metal of the metallic substrate. On this point, Applicant notes that the aluminum coating of Aulick is applied over an abrasive layer 17, and apparently not directly in contact with the metal of the bar 2. See col. 2, lines 60-63 ("Aluminum layer 15 is plated on abrasive layer 17, which is a mixture of silicon carbide particles and a phenolic resin binder coated and hardened on laminate 5."). Thus, even if the rigid metal bar 2 of Aulick was changed to be flexible, as

suggested by the Examiner, the resulting structure would not have the coating 15 in direct contact with the bar 2, but would instead have the abrasive layer 17 therebetween. Accordingly, Applicant respectfully submits that neither Aulick nor Kinoshita, alone or in combination, teach a structure meeting all the limitations of dependent claim 12.

### **Claims 15-19**

Independent claim 15 requires, *inter alia*, a metallic coating of not more than 30 um thickness on a flexible metallic substrate, with the coating comprising molybdenum and/or tungsten carbide and having a surface roughness of  $\leq 2.0$  um Ra. In addition to the numerous reasons given above with respect to claim 1, Applicant submits that independent claim 15 defines patentable subject matter because the Examiner has completely failed to address either the 30 um thickness limitation or the surface roughness limitation. Nor has the examiner addressed any of the additional limitations present in the dependent claims. Therefore, Applicant submits that the Examiner has failed to present a prima facie case of obviousness for these claims. Accordingly, Applicant submits that independent claim 15, and its dependent claims 16-19, define patentable subject matter over the cited art.

### **Claims 20-24**

Independent claim 20 requires, *inter alia*, a metallic coating on a flexible metallic substrate, with the coating comprising molybdenum and/or tungsten carbide. For the reasons given above with respect to claim 1, Applicant submits that the Examiner has

failed to present a prima facie case of obviousness for independent claim 20. Further, the Examiner has failed to address any of the additional limitations present in the dependent claims, e.g., surface roughness in claims 22-23. Therefore, Applicant submits that the Examiner has failed to present a prima facie case of obviousness for these dependent claims. Accordingly, Applicant submits that independent claim 20, and its dependent claims 21-24, define patentable subject matter over the cited art.

### **Claims 25-35**

Independent claim 25 requires, *inter alia*, a metallic coating on a flexible metallic substrate, with the coating comprising molybdenum and/or tungsten carbide. For the reasons given above with respect to claim 1, Applicant submits that the Examiner has failed to present a prima facie case of obviousness for independent claim 25. Further, the Examiner has failed to address any of the additional limitations present in the dependent claims, e.g., coating thickness in claims 26-27, surface roughness in claims 30-32. Therefore, Applicant submits that the Examiner has failed to present a prima facie case of obviousness for these dependent claims. Accordingly, Applicant submits that independent claim 25, and its dependent claims 26-35, define patentable subject matter over the cited art.

### **Claims 36-46**

Independent claim 36 requires, *inter alia*, a metallic coating on a flexible metallic substrate, with the coating comprising molybdenum and/or tungsten carbide. For the reasons given above with respect to claim 1, Applicant submits that the Examiner has

failed to present a prima facie case of obviousness for independent claim 36. Further, the Examiner has failed to address any of the additional limitations present in the dependent claims, e.g., coating thickness in claims 37-38, surface roughness in claims 41-43. Therefore, Applicant submits that the Examiner has failed to present a prima facie case of obviousness for these dependent claims. Accordingly, Applicant submits that independent claim 36, and its dependent claims 37-46, define patentable subject matter over the cited art.

#### **Claims 47-79**

As amended, independent claim 47 requires, *inter alia*, a metallic coating on a flexible metallic substrate, with the coating comprising molybdenum. Applicant submits that whatever Aulick and/or Kinoshita may or may not teach with respect to tungsten carbide coatings on doctor blades, it is undisputed that neither Aulick or Kinoshita teach anything with respect to coatings containing molybdenum on flexible substrates used for toner regulating members. As such, Applicant submits that claim 47, and its dependent claim 49, defines patentable subject matter over the cited art.

#### **New Claim 50**

Newly added claim 50 depends directly from Independent claim 1 and requires, *inter alia*, that the metallic coating comprise molybdenum. As pointed out above with respect to claim 47, neither Aulick or Kinoshita teach anything with respect to coatings containing molybdenum on flexible substrates used for toner regulating members. As

such, Applicant submits that dependent claim 50 defines patentable subject matter over the cited art, even if claim 1 does not.

In view of the above, Applicant submits that all presently pending claims are in condition for allowance. However, if any issues remain, the Examiner is specifically requested to telephone the undersigned so that they may be expeditiously resolved.

Respectfully submitted,  
COATS & BENNETT, P.L.L.C.



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